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Phone:	571-272-6086	**Date:**	February 28, 2007
Re:	USSN: 10/714,766 Our Docket: 17264	**CC:**	

REPLY TO EXAMINER'S ANSWER

The following is being filed with the U.S. Patent and Trademark Office via facsimile on February 28, 2007:

1. Reply to Examiner's Answer
2. Certificate of Transmission Under 37 CFR 1.8

Applicant:	Takeaki Nakamura
Serial No.:	10/714,766
For:	REMOTE OPERATION SUPPORT SYSTEM AND METHOD
Filed:	November 17, 2003
Docket:	17264
Dated:	February 28, 2007
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REPLY BRIEF

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No:	10/714,766	**Art Unit:**	3739
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Mail Stop Appeal Brief- Patents
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Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Sir:

Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated December 28, 2006.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to facsimile number 571-273-8300 at the U.S. Patent and Trademark Office on the date shown below.

Dated: February 28, 2007

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REMARKS

A: There Is No Motivation Or Suggestion To Combine The Remote Surgery Support System Of Uchikubo With The Tele-Surgical System Of Moll:

In section 10 of the Examiner's Answer (pages 7-9), the Examiner argues against the arguments presented by Appellant in section IX(A)(i) (pages 20-24) of the Supplemental Appeal Brief submitted on September 25, 2006. The Examiner argues against Appellants arguments that there is no motivation or suggestion to combine the remote surgery support system of Uchikubo with the tele-surgical system of Moll by citing old case law from the CCPA in support of his arguments and ignoring the more recent precedent of the Federal Circuit (as outlined in the Appeal Brief).

Specifically, the Examiner cites In re McLaughlin, 443 F.2d 1392 (CCPA 1971) to argue that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning" which is proper as long as such hindsight reasoning "takes into account only knowledge which was within the level of ordinary skill at the time of the claimed invention was made" and "does not include knowledge gleaned only from the applicant's disclosure."

The Appellant disagrees with the Examiner's arguments and with the application of the In re McLaughlin case.[1] It is clear from recent case law precedent of the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") what the legal test is for rejections under 35 U.S.C. § 103(a). Recent case law precedent from the Federal Circuit, such as that held in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998) and In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) make it clear that no amount of hindsight

1 The In re McLaughlin opinion has not been followed by any other court in any other subsequent proceedings (Keyciting the In re McLaughlin case on Westlaw® results in no other citing history).

reasoning is permitted in an analysis under 35 U.S.C. § 103(a). What is required is a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.[2]

In section 10 of the Examiner's Answer, the Examiner further cites In re Gershon, 152 USPQ 602 (CCPA 1962) as supporting the argument that "the mere fact that the prior art references of record fail to evince an appreciation of the problem identified and solved by applicant is not, standing alone, conclusive evidence of the nonobviousness of the claimed subject matter."

As argued in the Appellant's Appeal Brief, in the Final Official Action, the Examiner argues motivations which are not related to the objectives of the present invention, namely to prevent the operator in the operating room from receiving all of the information units from supporting rooms. Thus, the Appellant respectfully submitted that the motivation cited by the Examiner for combination of the Uchikubo and Moll references is not proper because the inventors of the Uchikubo and Moll references were faced with different problems. As support for the Appellant's position, the Appellant cited a very recent Federal Circuit decision, Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (citing Ruiz v. A.B. Chance Co., 357, F.3d 1270, 1275 (Fed. Cir. 2004)). Such decision specifically holds that 35 U.S.C. § 103(a) requires "... a showing that an artisan of ordinary skill in the art at the time of the invention, **confronted by the same problems as the inventor** and with no knowledge of the claimed invention, would have selected the

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2 See also Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (cited in the Appeal Brief and discussed below) which holds that 35 U.S.C. § 103(a) requires "... a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and **with no knowledge of the claimed invention**, would have selected the various elements from the prior art and combined then in the claimed manner" (emphasis added).

various elements from the prior art and combined then in the claimed manner" (emphasis added). Thus, the Examiner replies to the Appellant's citations from such very recent precedent by the Federal Circuit with an outdated case law citation from 1961 and the CCPA.[3]

Since the Uchikubo and Moll references are directed to solving different problems, those of ordinary skill in the art could not have been motivated to combine the teachings thereof. Uchikubo is simply directed to making it possible to check or display the state of a surgical instrument and/or patient information in a remote place (column 1, lines 51-60). Moll is simply directed to methods for coupling input devices to robotic manipulator arms during surgery (see column 1, lines 26-31). Neither of such objectives are even remotely related to the objective of the present invention, namely, to prevent the operator in the operating room from receiving all of the information units from supporting rooms. Therefore, unnecessary information can be "filtered" and/or integrated by a single primary support room, which prevents the operator from receiving unnecessary information (see page 9, lines 13-21 of the present disclosure) and also leads to an operation that is performed correctly, rapidly and reliably (see page 16, lines 4-8 and page 18, lines 8-9 of the present disclosure). Neither Uchikubo nor Moll suggest such problems nor contemplate their solution.

In light of the state of the law as set forth by the Federal Circuit with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejection for obviousness under 35 U.S.C. § 103(a) is improper and must be withdrawn.

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3 The In re Gershon opinion has not been followed by any other court in any other subsequent proceedings (Keyciting the In re Gershon case on Westlaw® results in no other citing history).

B: The Combination Of Uchikubo And Moll Does Not Show All of the Features of the Claimed Invention:

The Examiner argues that the "third control system" recited in the claims is disclosed in Figure 27 of Moll. Appellant disagrees and submits that in Figure 27 of Moll there is not disclosed such primary support room and secondary support room which are different in their functions as in the claimed invention.

C: Conclusion

Based on the above arguments and remarks, Appellants respectfully submit that the claims of the instant invention on appeal are not obvious in light of the combination of Uchikubo and Moll. Consequently, the rejection of the claims based on such references is in error. In view of the remarks submitted hereinabove, the references applied against Claims 1-21 on appeal do not render those claims unpatentable under 35 U.S.C. § 103. Thus, Appellants submit that the § 103 rejection is in error and must be reversed.

Respectfully submitted,

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